



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,479	08/03/2001	Thomas Zettler	J&R-0694	7212

24131 7590 05/31/2006

LERNER GREENBERG STEMER LLP  
P O BOX 2480  
HOLLYWOOD, FL 33022-2480

EXAMINER
----------

CHUNG, PHUNG M

ART UNIT	PAPER NUMBER
----------	--------------

2138

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/922,479

Applicant(s)

ZETTLER, THOMAS

Examiner

Phung My Chung

Art Unit

2138

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2006 and 10 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-17, 19-23 and 29 is/are pending in the application.
- 4a) Of the above claim(s) 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-17, 19-23 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/3/06</u> | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2138

**Election Without Traverse**

1. Applicant's election without traverse of Group I, claims 1-4, 6-17, 19-23 and 29 on March 10, 2006 is acknowledged.

**Single Means Claim:**

2. Claims 11 and 12 are single means claims, i.e., "a self-test control device..." does not appear in combination with another recited element or means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claims which covered every conceivable means for achieving the stated purpose was held non-enabling for the scope of the claim because the specification disclosed at most only those means known to the inventor). (See MPEP 2164.08(a)).

As per claims 13 and 15, these claims are also rejected because they dependent upon the rejected based claim.

***Claim Rejections - 35 USC § 112***

3. Claims 1-4, 6-10, 14, 16-17, 19-23 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, lines 7-9, "taking at least parts of the integrated circuit ..device" is not clear as to what it means. It is unclear how and why the parts of integrated circuit is taking out

Art Unit: 2138

after have been tested by the self-test device. Appropriate correction and/or clarification is required.

As per claims 2-3, these claims are rejected because they dependent upon the rejected based claim.

As per claim 4, lines 5-6, "moving the control device..circuit" is not clear how the control device moving together with the integrated circuit. Appropriate correction and/or clarification is required.

As per claim 6, this claim is rejected because it dependent upon the rejected based claim.

As per claim 7, lines 3-5, "including not supplying a clock signal,..., to the parts of the integrated circuit" is a negative limitation. Appropriate correction and/or clarification is required.

As per claim 8, lines 3-5, "including not supplying a supply voltage,..., to the parts of the integrated circuit" is a negative limitation. Appropriate correction and/or clarification is required.

As per claims 9-10, these claims are rejected because they dependent upon the rejected based claim.

As per claim 14, lines 2-3, "said self-test control device...circuit" is not clear how the control device moving together with the integrated circuit. Appropriate correction and/or clarification is required.

As per claim 16, lines 3-7, "a self-test device...; and

Art Unit: 2138

a device for,....said components" the interconnection and/or interrelation between these device are unknown.

As per claims 17, 19-23, these claims are rejected because they dependent upon the rejected based claim.

As per claim 29, lines 3-7, "a self-test device...;

a device for,....said components" the interconnection and/or interrelation between these device are unknown.

4. Applicant's arguments with respect to claims 1-4, 6-17, 19-23 have been considered but are moot in view of the new ground(s) of rejection.


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phung My Chung whose telephone number is 571-272-3818. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571- 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 2138

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phung My Chung  
Primary Patent Examiner